



Legal Network International

IP and trade mark news – February 2024

A monthly update on global IP and trade mark news from the member firms of the Legal Network International (LNI).



Bulgaria

In December 2023 significant amendments to the Bulgarian Copyright Act have been enacted. One notable change pertains to the maximum duration for which a copyright can be licensed. Under Bulgarian law, copyrights are generally considered non-transferable. The copyright holder cannot assign it but can only grant an exclusive or non-exclusive license for a specific period. Until recently, the maximum period by law for granting a copyright license was 10 years. However, the latest amendments have repealed this provision, effectively removing any restrictions on the licensing period. As a result, perpetual licenses are now legally permissible. This significant legal development is anticipated to positively influence the IT industry, especially in relation to software license agreements governed by Bulgarian law.

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Canada

In Canada, summary cancellation proceedings are available at a low cost to expunge trademarks that are not in use. In some cases a trademark may be sustained in the face of such attack by proving that the trademark was intended to be used in the near future. When purchasing a brand, it may be helpful to perform due diligence to ensure that the trademark is in use and has not been abandoned, as was the case in a recent decision. See our blog post "Use it or lose it: Summary Trademark Expungement in Canada" for more details. <https://www.airdberlis.com/insights/blogs/thespotlight/post/ts-item/use-it-or-lose-it-summary-trademark-expungement-in-canada>

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China

On December 29, 2023, the CNIPA issues *Guidelines on Correctly Understanding Goods and Services for Trademark Registration* to help business operators understand and choose goods and services for trademark registration.

The Guidelines summarise characteristics of China's unique classification of similar goods and services and explain the rationale behind it.

The Guidelines further illustrate important issues under different circumstances. For example, for the purpose of trademark registration, applicants are recommended to cover goods / services based on their actual needs and refrain from filing applications on goods / services without actual intention for use. However, for monitoring potentially infringing trademark applications, business operators are recommended to expand the scope of goods / services if their trademarks are popular.



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In a summary proceedings, a manufacturer of packaging for cosmetics products has initiated a proceeding against a former client which has used an alleged identical packaging:



France



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Despite an accurate description of the characteristics of the product, French Paris Court of Appeal has judged that copyright cannot be invoked given the lack of the originality of the product.

French Judges have also rejected parasitism given that there is no individualized economic value or specific investments for the litigious product, despite the production of three series of sketches and two documents attesting the purchase of machines for the litigious products.



India

PepsiCo's battle over the FL-2027 potato variety took a new turn when the Protection of Plant Varieties and Farmers' Rights Authority (PPVFRA) revoked its varietal registration certificate. PepsiCo contended that FL-2027 is a specialized chipping potato tailored for Lay's chips, and unsuitable for household cooking. Farmer's Activist Kuruganti's argued that PepsiCo cited false information, leading to revocation of its certificate. After Single Bench's dismissal of PepsiCo's appeal, the company challenged the decision at the Delhi High Court. The court delved into the complexities of PPVFRA Regulations. Ultimately, the court rejected Kuruganti's arguments against PepsiCo's patent registration and paved the way for PepsiCo's renewal application to be reinstated, signalling towards a legislative gap requiring a robust mechanism for future prevention.


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Italy

The Milan Court of first instance recently stated that the evocation of geographical indication shall be intended as any recall, even of a descriptive or figurative nature, to the geographical origin of the product. Regulation 2019/787 provides that to be classified as Scotch Whisky, it is necessary for Scotland to be the place of production, distillation, and ageing of the spirit. Therefore, the use of elements within a front label suggesting the Scottish origin of a spirit – such as emblems and heraldic symbols evoking the United Kingdom and Scotland – to commercialise a whisky produced outside Scotland constitutes per se an unlawful use of the protected geographical indication.

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Mexico

In Mexico, on January 29, 2024, the Supreme Court determined that section I, last paragraph, of article 151 of the Industrial Property Law (repealed) is constitutional, which establishes that the actions for nullity of the registration of a trademark that has been granted in violation of the provisions of the law may be exercised at any time. This is because the Supreme Court establishes that a registration derived from an illegal grant may be challenged at any time, since the mere passage of time cannot cure its illegality. Therefore, the Supreme Court upheld the judgment of the respective Collegiate Circuit Court and granted the "amparo" to the plaintiff.

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Sweden

A legislative commission has forwarded a proposal for new limitations on copyright to the Swedish Government, see report SOU 2024:4. The report suggests an introduction of both widened and more precise prerequisites in provisions governing the statutory limitations on copyright. The suggested rules are of particular interest to mass media reporting current events. Further, the report assesses that it is not yet time for suggesting restrictions on the use of AI when it comes to copyright protected material. The amendments are proposed to enter into force in September 2025.

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UK

On 20 December 2023, in *Thaler v Comptroller-General of Patents, Designs and Trade Marks [2023] UKSC 49*, the UK Supreme Court unanimously decided that a machine embodying an artificial intelligence (AI) system could not be named as the inventor in a patent application under the Patents Act of 1997 (UK). The ruling of this landmark case is unsurprising and consistent with the decisions of the courts or offices of Germany, Australia and the U.S.
<https://www.supremecourt.uk/cases/docs/uksc-2021-0201-judgment.pdf>

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